

REQUEST FOR WITHDRAWAL OF FINAL STATUS OF REJECTION
UNDER MPEP §706.07(a)

It is respectfully requested that the Final status of the outstanding rejection be withdrawn, because the rejection was made on prior art not of record, of a claim reasonably amended to include reasonably expected limitations. This action should not have been made final.

MPEP §706.07(a) states that “A second or any subsequent action on the merits in any application ... should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed.” In this case, the Seitz ‘845 patent is a new ground of rejection as the previous Office Action only cited GB Patent No. 1 214 330 to Baldwin-Ehret-Hill Inc., U.S. Patent No. 3,346,016 to Blau et al., U.S. Patent No. 3,824,140 to Hofmann, U.S. Patent No. 5,056,564 to Roth, U.S. Patent No. 4,576,206 to Lauren, and U.S. Patent No. 5,457,136 to Hartranft et al.

This new ground for rejection of claim 13 could not have been necessitated by Applicants’ Amendment filed July 7, 2008 as Applicants merely rephrased the previously rejected claim 12 into the present claim 13, no new features were added to claim 13, and therefore no new subject matter was introduced (please see discussion in response to 112, first paragraph rejection with respect to newly presented claims 19 and 20). Contrary to the rule promulgated in the MPEP, the Examiner cited new art, as discussed above. Therefore, the finality of this action should be withdrawn.

MPEP §706.07(a) states:

706.07(a)Final Rejection, When Proper on Second Action

... Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by Applicant’s amendment of the claims nor based on information submitted in an information disclosure statement ...

MPEP §706.07(a) further sets forth standard paragraph 7.40.01 and Note 1:

"Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL...**"

Examiner Note:

1. This form paragraph should not be used and a final rejection is improper where there is another new ground of rejection introduced by the examiner which was not necessitated by amendment to the claims.

The new grounds were not necessitated by amendment, except for the fact that the amendment properly overcame the previous grounds for rejection. In other words the new grounds were not "necessitated by Applicant's amendment of the claims". (MPEP §706.07(a).) Therefore, a Final Rejection at this time would deny Applicants "a full and fair hearing, and that a clear issue between Applicants and examiner should be developed, if possible, before appeal."

REMARKS

Claims 1-3, 5-11, 13-17, 19 and 20 are presented for reconsideration and withdrawal of the rejections set forth in the Final Office Action dated September 18, 2008, and further examination in view of the foregoing amendments and following remarks.

In the outstanding Office Action, the Examiner rejected claims 9, 10, 14 and 18 under 35 U.S.C. §102(b) as being anticipated by GB Patent No. 1 214 330 to Baldwin-Ehret-Hill Inc. (hereinafter referred to as “the B-E-H Inc. ‘330 patent”).

In the outstanding Office Action, the Examiner rejected claims 1, 2, 6-8 and 19 under 35 U.S.C. §103(a) as being unpatentable over the B-E-H Inc. ‘330 patent in view of U.S. Patent No. 3,346,016 to Blau et al. (hereinafter referred to as “the Blau et al. ‘016 patent”); rejected claim 5 under 35 U.S.C. §103(a) as being unpatentable over the B-E-H Inc. ‘330 patent in view of the Blau et al. ‘016 patent, as applied to claim 1 above, in view of U.S. Patent No. 3,824,140 to Hofmann (hereinafter referred to as “the Hofmann ‘140 patent”); rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over the B-E-H Inc. ‘330 patent in view of the Blau et al. ‘016 patent, as applied to claim 2 above, in view of U.S. Patent No. 5,056,564 to Roth (hereinafter referred to as “the Roth ‘564 patent”); rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over the B-E-H Inc. ‘330 patent, as applied to claim 9 above, in view of the Roth ‘564 patent; rejected claim 13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,576,206 to Lauren (hereinafter referred to as “the Lauren ‘206 patent”) in view of GB Patent No. 2 032 845 to Seitz (hereinafter referred to as “the Seitz ‘845 patent”); rejected claims 9, 15, 16 and 20 under 35 U.S.C. §102(b) as being unpatentable over the Blau et al. ‘016 patent in view of the Seitz ‘845 patent; and rejected claim 17 under 35 U.S.C. §102(b) as being unpatentable over the B-E-H Inc. ‘330 patent, as applied to claim 9 above, in view of U.S. Patent No. 5,457,136 to Hartranft et al. (hereinafter referred to as “the Hartranft et al. ‘136 patent”).

By this amendment, claims 1, 2, 5, 9 and 13 have been amended. Claim 18 has been cancelled without prejudice or disclaimer to the contents therein. In this regard, Applicants note that amended claim 9 is a combination of the subject matter of previously presented claim 9 and previously presented, now cancelled, claim 18. Claims 2 and 5 have been amended only to

explicitly state which features are referred to by the terms "it" and "its." Similar amendments have been made to claims 1, 9 and 13. The amended claims clarify the subject matter recited in the rejected claims.

It is respectfully submitted that the above amendments introduce no new matter within the meaning of 35 U.S.C. §132.

Claim Rejections under 35 U.S.C. § 102(b)

The Examiner rejected claims 9, 10, 14 and 18 under 35 U.S.C. §102(b) as being anticipated by the B-E-H Inc. '330 patent.

Response

By this Response and Amendment, claims 9, 10 and 14 have been amended or depend from amended claims and, as amended, the rejections thereto are respectfully traversed. Claim 18 has been cancelled without prejudice or disclaimer to the contents therein. Therefore, the rejection thereto is moot.

For a reference to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131.

Amended claim 9 recites:

"Pipe sleeve (20; 30) made of mineral wool for insulating pipelines, the pipe sleeve being formed of a wound continuous nonwoven web (21; 31) with cured binder, characterized in that there is at least one reinforcing layer (22; 32, 33) on the inner side of the pipe and/or enclosed at at least part of the boundary between successive wound layers,

further characterized in that a reinforcing layer (13) in the form of a trickle guard is

wound fully circumferentially around said pipe sleeve,

and further characterized in that the reinforcing layer is provided with means for allowing separation of wound layers in order to reduce external or internal diameter of the pipe."

The B-E-H Inc. '330 patent discloses (page 3, lines 33-35) that "the pipe cover 10 is formed by spirally winding super-imposed mats of different fibrous materials into a tubular form...". Under correct consideration of the cited paragraphs on page 3, lines 35-40, Applicants respectfully submit that the complete teaching in this regard is that superimposed *mats* of different fibrous material are spirally wound into a two layer form with one layer being the outer layer and made of glass fibers, while the other layer creating the intermediate layers is made of mineral wool.

Firstly, claim 9 has been amended to clarify that the nonwoven web is provided continuously, as supported in the original specification and figures, further reinforced through the use of first and second supply belts and a winding mandrel. Importantly, the specification of the presently claimed subject matter does not disclose the use of mats of material. Indeed, mats of material would not be easily implemented on such mechanisms without additional control systems, etc. Thus, the B-E-H Inc. '330 patent is at least deficient for the reason that it fails to disclose, teach or suggest "the pipe sleeve being formed of a wound continuous nonwoven web" as recited in amended claim 9.

Additionally, Applicants note that according to this piece of art, the process starts with two mats superimposed with each other. Applicants respectfully submit that if one were to put a couple of mats onto a mandrel and wind it thereon revolution by revolution, it is clear to someone of ordinary skill in the art that, because of the different diameters acting on each of the mats, the trailing ends thereof will not rest on the same place at the outside of the finished sleeve. In other words, the trailing end of the outer layer will rest at the sleeve body at a position where the trailing end of the inner layer is not reached. Thus, the outer layer of such construction typically does not completely surround the roll so that the second layer will be visible from the outside.

Claim 9 has also been amended to include that the reinforcing layer is provided with means for allowing separation of wound layers in order to reduce external or internal diameter of the pipe. With respect to this feature, found in claim 18, rejected by the Examiner under Item 4 of the Office Action over the B-E-H Inc. '330 patent, Applicants note that although the Examiner has cited page 3, lines 40-45 "slit" of the B-E-H Inc. '330 patent as disclosing such features of previously presented claim 18, this Examiner referred to "slit" of the B-E-H Inc. '330 patent could be either "a longitudinally extending slit 12 through the sidewall" or "a partial slit 14 diametrically opposed therefrom" both of which "divid[ing] the pipe cover in halves 10a and 10b connected by a hinge 16 so that it may be opened as illustrated in Figure 4...". In either case, the slit may reduce external circumference of the pipe in that the pipe becomes halved, but with respect to the diameter of the pipe itself, neither an external or internal diameter is reduced resultingly.

Also, Applicants note that no explicit teaching is given in the B-E-H Inc. '330 patent to provide a reinforcing layer at the outer circumferentially side of a sleeve body which is wound all around thereof. Moreover, no teaching is given that such outer layer may act as a trickle guard. The asserted reinforcing layer is not "wound *fully circumferentially* around the pipe," as recited in amended claim 9, due to the presence of the slits of the B-E-H Inc. '330 patent.

Accordingly, Applicants respectfully submit that the B-E-H Inc. '330 patent does not disclose, teach or suggest all claimed features of amended claim 9. Therefore, it is submitted that the features of amended claim 9, and therefore claim 9 are patentable over the B-E-H Inc. '330 patent.

Therefore, claims 10 and 14, dependent from claim 9 are patentable at least due to their dependency from claim 9.

Accordingly, Applicants respectfully requests reconsideration and withdrawal of the outstanding rejections.

Claim Rejections under 35 U.S.C. §103(a)

The Examiner rejected claims 1, 2, 6-8 and 19 under 35 U.S.C. §103(a) as being unpatentable over the B-E-H Inc. '330 patent in view of the Blau et al. '016 patent; rejected claim 5 under 35 U.S.C. §103(a) as being unpatentable over the B-E-H Inc. '330 patent in view of the Blau et al. '016 patent, as applied to claim 1 above, in view of the Hofmann '140 patent; rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over the B-E-H Inc. '330 patent in view of the Blau et al. '016 patent, as applied to claim 2 above, in view of the Roth '564 patent; rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over the B-E-H Inc. '330 patent, as applied to claim 9 above, in view of the Roth '564 patent; rejected claim 13 under 35 U.S.C. § 103(a) as being unpatentable over the Lauren '206 patent in view of the Seitz '845 patent; rejected claims 9, 15, 16 and 20 under 35 U.S.C. §102(b) as being unpatentable over the Blau et al. '016 patent in view of the Seitz '845 patent; and rejected claim 17 under 35 U.S.C. §102(b) as being unpatentable over the B-E-H Inc. '330 patent, as applied to claim 9 above, in view of the Hartranft et al. '136 patent.

Response

These rejections are traversed as Applicants submit that the Examiner is missing a number of arguably novel features of the presently claimed subject matter. In order to establish a *prima facie* case of obviousness, the Examiner must establish: (1) some suggestion or motivation to modify the reference(s) exists; (2) a reasonable expectation of success; and (3) the prior art references teach or suggest all of the claim limitations.

Amended claim 1 of the pending application recites:

"Process for producing pipe sleeves (10; 20; 30; 50) made of mineral wool for insulating pipelines or for reducing the sound level in pipeline systems, comprising the following steps:

- a) providing a continuous nonwoven web (11; 21; 31; 51) made of mineral wool which is provided with an uncured binder,
- b) winding up the nonwoven web (11; 21; 31; 51) on a winding mandrel (2) of a winder,

c) curing the binder,

characterized in that

at least one reinforcing layer (12, 13; 22; 32, 33; 52) is provided before the nonwoven web (11; 21; 31; 51) runs into the winder, in such a way that during the winding the said reinforcing layer becomes a constituent part of the pipe sleeve produced as a result, and

further characterized in that the reinforcing layer (13) is added to the trailing end of the nonwoven web (11) in such a way that said reinforcing layer comes to lie on the outside of the pipe sleeve (10) with the effect of a lamination, as the last layer arranged around the full circumference."

As discussed above, Applicants respectfully submit that the B-E-H Inc. '330 patent does not disclose, teach or suggest "providing a continuous nonwoven web made of mineral wool" as recited in amended claim 1.

Further to the presently claimed subject matter, the B-E-H Inc. '330 patent is not fully enabling to disclose, teach or suggest that "at least one reinforcing layer... is provided before the nonwoven web... runs into the winder" as recited in independent claim 1. The Examiner has cited page 3, lines 35-40 and page 3, lines 55-60 of the B-E-H Inc. '330 patent as supporting such disclosure, but lines 35-40 disclose only that "the outer layer *L_f* and every other layer being made of glass fibre and the intermediate layers *L_m* between the glass fibre layers being made of mineral wool." Thus, the B-E-H Inc. '330 patent merely discloses that the outer layer and "every other layer" is made of a glass fibre, but does not discuss the composition of the inner most layer. Accordingly, the B-E-H Inc. '330 patent suggests that the composition of the inner most layer depends on whether the number of layers is odd or even. Applicants do not understand the applicability of the citation of lines 55-60 of the B-E-H Inc. '330 patent, which discuss the density of the finished cover and a comparison to "straight glas fibres," both elements that are not discussed in this portion of claim 1.

Admittedly, the B-E-H Inc. '330 patent does not disclose "that the reinforcing layer is

added to the trailing end of the nonwoven web” as recited in independent claim 1. Applicants note that the Examiner agrees that the B-E-H Inc. ‘330 patent does not disclose the features of claim 1 according to which the reinforcing layer is added to the trailing end of the nonwoven web. In this regard, he specifically refers to the Blau et al. ‘016 patent, asserting that such a feature is disclosed in column 5, lines 55-65. Applicants respectfully disagree with the Examiner. Applicants agree that the Blau et al. ‘016 patent teaches to roll a glass fiber felt on a mandrel, but disagree with the Examiner’s interpretation that the Blau et al. ‘016 patent teaches “that at least one reinforcing layer is provided *before* the nonwoven web runs into the winder” (emphasis added) as recited in Applicants’ claim 1. However, the Blau et al. ‘016 patent discloses (col. 5, lines 62-66) that “upon completion of the first revolution an aluminum foil will be inserted between the convolutions of the fiber felt with continuing the wrapping of the foil until five complete continuous spirals of foil are formed... whereupon the inclusion of the foil was terminated and the convoluting of glass fiber was continued...” (emphases added). This construction is shown in the figure of the Blau et al. ‘016 patent, wherein the metal foil is indicated by reference numeral 3 as described in col. 5, lines 33-47 of the Blau et al. ‘016 patent.

Hence, there is not only *no* disclosure in the Blau et al. ‘016 patent to add a reinforcing layer *before* the inclusion of nonwoven web in the pipe sleeve, but there is also *no* disclosure to add a reinforcing layer to the trailing end of the nonwoven web. In addition, the Blau et al. ‘016 patent does not disclose a pipe sleeve having a reinforcing layer arranged around the full circumference of the sleeve body.

Therefore, Applicants respectfully submit that the Blau et al. ‘016 patent fails to cure the deficiencies of the B-E-H Inc. ‘330 patent with respect to independent claim 1.

Accordingly, the features of independent claim 1 are patentable, and claim 1 is patentable over the B-E-H Inc. ‘330 patent and the Blau et al. ‘016 patent individually, or in combination. Similarly, all claims dependent from claim 1, including claims 2, 6-8 and 19, are patentable over the B-E-H Inc. ‘330 patent and the Blau et al. ‘016 patent, whether applied individually, or in combination, at least because of their dependency from claim 1.

Applicants assert that the claims dependent from claim 1 have additional patentable features, notwithstanding.

For example, with respect to dependent claim 7, Applicants respectfully disagree with the Examiner's citation of page 3, lines 80-85 of the B-E-H Inc. '330 patent as disclosing "that the reinforcing layer is wetted with additional binder before being provided for the winding operation." These lines of the B-E-H Inc. '330 patent discuss "mineral wool impregnated with a suitable thermosetting binder," which is notably not a reinforcing layer, and a few lines prior "glass fibre impregnated with a suitable thermosetting binder," but do not discuss any "that the reinforcing layer is wetted with *additional* binder." Thus, for at least this reason, the B-E-H Inc. '330 patent fails to teach, disclose or suggest the features of dependent claim 7.

With respect to dependent claim 5, rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over the B-E-H Inc. '330 patent in view of the Blau et al. '016 patent, as applied to claim 1 above, in view of the Hofmann '140 patent, Applicants submit that the Hofmann '140 patent fails to cure the deficiencies of the combination of the B-E-H Inc. '330 patent and the Blau et al. '016 patent with respect to independent claim 1, as discussed above. For example, the Hofmann '140 patent again discusses a split pipe sleeve, thereby unable to provide at least a "last layer arranged around the full circumference" as recited in Applicants' present claims. The Hofmann '140 patent even discusses that an additional "thin insulating layer 26 is inserted between the confronting faces of the sheath..." thereby further making it impossible for a "last layer to be arranged around the full circumference" as recited in Applicants' independent claim 1. Additionally, Applicants respectfully submit that while the Examiner's introduction of the Hofmann '140 patent is admittedly to address that "the reinforcing layer is applied to the mandrel before the winding of the nonwoven web in such a way that it provides the inner surface of the pipe sleeve determining the clear internal diameter of the pipe sleeve" as recited in Applicants' dependent claim 5, in contrast to the presently claimed subject matter, the "synthetic-resin foil sleeve 24" disclosed in col. 4, lines 1-4 which "the coiling mandrel is first provided with" is not of the same material as the "metal-foil layers 22"

which assertedly provide reinforcement layers to the “insulating fabric layers 21” of the Hofmann ‘140 patent. Thus, in addition to failing to cure the deficiencies of the previously discussed combination, the Hofmann ‘140 patent also fails to disclose that “*the* at least one reinforcing layer... is applied to the winding mandrel... *the* said reinforcing layer provides the inner surface of the pipe sleeve determining the clear internal diameter” as there is no consistency in the Hofmann ‘140 patent as to which ‘reinforcement material’ is used. Thus, for at least these reasons, the cited combination fails.

With respect to claim 3, rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over the B-E-H Inc. ‘330 patent in view of the Blau et al. ‘016 patent, as applied to claim 2 above, in view of the Roth ‘564 patent, Applicants respectfully submit that the Roth ‘564 patent fails to cure the deficiencies of the combination of the B-E-H Inc. ‘330 patent and the Blau et al. ‘016 patent with respect to amended independent claim 1, which claims 2 and 3 depend from, directly and indirectly, respectively, as discussed above.

With respect to claim 11, rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over the B-E-H Inc. ‘330 patent, as applied to claim 9 above, in view of the Roth ‘564 patent, Applicants submit that the Roth ‘564 patent fails to cure the deficiencies of the B-E-H Inc. ‘330 patent with respect to amended independent claim 9, which claim 11 depends from, as discussed above.

With respect to claim 13, rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over the Lauren ‘206 patent in view of the Seitz ‘845 patent, Applicants respectfully submit that the combination is improper and thus fails as col. 4, lines 64-64 of the Lauren ‘206 patent discloses that the “inner layer 3, which also consists of mineral wool” while page 2, lines 10-16 of the Seitz ‘845 patent discloses an “outer layer of glass wool.” Thus, the combination not only fails to disclose use of the same material for the reinforcing layer, but further, fails to disclose as recited in amended claim 13, “said pipe sleeve further characterized in that the

reinforcing layer is one of or a combination of a glass nonwoven or a woven glass fibre fabric; or includes one of a particulate material, a particulate infrared radiation absorbing material or a particulate heat shielding material; or includes one of a foil material, or a heat reflective foil containing a metal; or is treated with a biocide agent.”

With respect to claims 9, 15, 16 and 20, rejected by the Examiner under 35 U.S.C. §102(b) as being unpatentable over the Blau et al. ‘016 patent in view of the Seitz ‘845 patent, Applicants respectfully submit that the Seitz ‘845 patent fails to cure the deficiency discussed above of the Blau et al. ‘016 patent of not disclosing a “pipe sleeve being formed of a wound continuous nonwoven web (21; 31) with cured binder, characterized in that there is at least one reinforcing layer (22; 32, 33) on the *inner side* of the pipe” as recited in amended claim 9 (emphasis added), as the Blau et al. ‘016 patent discloses introduction of metal foil after one rotation of the mandrel, and the Seitz ‘845 patent fails to disclose a reinforcing layer on the inner side of the pipe. Further, as the pipe of the Seitz ‘845 patent comprises only two layers, of two different mineral wools, preferably one rock, one glass, the Seitz ‘845 patent fails to disclose that “a reinforcing layer (13) in the form of a trickle guard is wound fully circumferentially around said pipe sleeve” as recited in amended claim 9, as the Examiner admits he is interpreting the layer as part of the pipe sleeve, and not an additional reinforcing layer. Finally, the combination fails to disclose the feature recited in amended claim 9 wherein “the reinforcing layer is provided with means for allowing separation of wound layers in order to reduce external or internal diameter of the pipe.”

With respect to claim 17, rejected by the Examiner under 35 U.S.C. §102(b) as being unpatentable over the B-E-H Inc. ‘330 patent, as applied to claim 9 above, in view of the Hartranft et al. ‘136 patent, Applicants respectfully submit that the Hartranft et al. ‘136 patent fails to cure the deficiencies of the B-E-H Inc. ‘330 patent with respect to amended independent claim 9, which claim 17 depends from, as discussed above.

As discussed above, Applicants respectfully submit that amended independent claims 1, 9 and 13 are patentable over the cited prior art, an indication of which is kindly requested.

Applicants respectfully submit that the teachings of the B-E-H Inc. '330 patent and the Blau et al. '016 patent, when considered, do not disclose the features of amended independent claim 1. Dependent claims 2, 3, 5-8, and 19 depend from independent claim 1. Accordingly, Applicants submit that dependent claims 2, 3, 5-8, and 19 are patentable at least by virtue of their dependency.

Applicants respectfully submit that the teachings of the Blau et al. '016 patent and the Seitz '845 patent, when considered, do not disclose the features of amended independent claim 9. Dependent claims 15, 16 and 20 depend from independent claim 9. Accordingly, Applicants submit that dependent claims 15, 16 and 20 are patentable at least by virtue of their dependency.

Applicants respectfully submit that the teachings of the B-E-H Inc. '330 patent in view of the Roth '564 patent, the teachings of the Lauren '206 patent in view of the Seitz '845 patent and the teachings of the B-E-H Inc. '330 patent in view of the Hartranft et al. '136 patent, when considered as discussed above, do not disclose the features of claims 11, 13 and 17, respectively.

It is therefore respectfully submitted that the rejections under 35 U.S.C. 103(a) should be withdrawn.

CONCLUSION

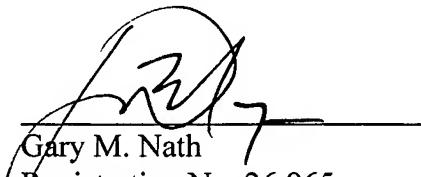
In light of the foregoing, Applicants submit that the application is in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicants respectfully request that the Examiner call the undersigned.

Respectfully submitted,

THE NATH LAW GROUP

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THE NATH LAW GROUP
112 South West Street
Alexandria, VA 22314-2891
Tel: 703-548-6284
Fax: 703-683-8396



Gary M. Nath
Registration No. 26,965
Jerald L. Meyer
Registration No. 41,194
Jiaxiao Zhang
Registration No. 63,235
Customer No. 20529